REMARKS

The Application has been carefully reviewed in light of the Office Action mailed May 30, 2007. Claims 1-62 are pending in this application. Claims 1-62 stand rejected. Reconsideration and allowance of all pending claims is respectfully requested in view of the following remarks.

Applicants note that the Examiner asserts that the claimed subject matter is not entitled to the date of the provisional application to which this application claims priority. While Applicants dispute such conclusion, the date of the provisional application is not necessary to overcome the Examiner's current rejections.

Rejections Under 35 U.S.C. § 103:

Claim 1

The Examiner has withdrawn the previous rejection of Claim 1 and now asserts that Claim 1 is not allowable under 35 USC 103(a) over U.S. Pub. No. 2002/0129067 to Dames et al. ("Dames") in view of U.S. Patent No. 5,937,162 ("Funk") in further view of U.S. Patent No. 6,199,076 to Logan ("Logan"). The Examiner asserts that Dames teaches certain elements of Claim 1, but admits that Dames does not disclose either an advertisement server or inserting advertisements into the user requested content. In further review of Dames, in paragraph [0040] specifically, it appears that content markers are being "associated with particular markup language tags, codes, and text. Moreover, particular content markers can cause the markup language application 160 to insert text within the data for improved end user understanding." This is the simple insertion of text to make data appear in a different format (i.e. from a word and two numerical values, to a more complete English-like phrase, as given in the example.) The instant application, in amended Claim 1, includes a web server that provides a "...means, responsive to a user request via the client device for Web content, for retrieving an advertisement from the advertisement server in response to the subject matter of the Web content; [and] means for inserting the retrieved advertisement within the user requested Web content..."). Inserting a content or subject matter related advertisement cannot fairly be considered equivalent to inserting two words to make a complete phrase from a series of fields in a database.

Additionally, Applicants reiterate and further clarify the argument presented in the Applicants' remarks dated March 6, 2007 with respect to Logan. Examiner asserts in section 4, page 2 of the Office Action dated May 30, 2007 that "Logan is simply relied upon to teach storing information associated with delivery of the advertisement. Logan is not being relied upon to teach translation of text to audio or that advertisements can be stored." Applicants respectfully disagree with the Examiner. Notwithstanding what Logan is being cited for, the combination of Logan with either or both Dames and Funk cannot teach away from the claimed invention. The conversion to an audio format before delivery to the user client device is exactly the opposite of what is disclosed in Logan. In fact, Logan specifically teaches away from conversion to an audio format before delivery to the user client device by stating in column 6, "If speech synthesis is used, the conversion of text to speech is preferably performed at the client station 103 by the player. In this way, text information alone may be rapidly downloaded from the server 101 since it requires much less data than equivalent compressed audio files, and the downloaded text further provides the user with ready access to a transcript of voice presentations." Combining the references, including the disclosure in Logan specifically teaching away from the present invention, would not produce the same result as the invention as claimed. Therefore, it is improper to combine Logan with Dames and Funk..

Even if the combination of Dames and Funk with Logan was proper, it cannot fairly be said that Logan expressly discloses an advertisement server that hosts advertisements in text-based format, as stated in paragraph 9 on page 7 of the Office Action. The Office Action notes, in the same paragraph, that "Funk does not expressly disclose an advertisement server but does disclose that the service processing system (where the advertisement insertion takes place) has access to source information database that hosts information in a text based format." Then, Logan is claimed to have an expressly disclosed advertisement server with the same basic setup that the Office Action claims is not an advertisement server in Funk. Item 130 in Logan is a Program Data Library which includes a database of Advertising 135, which cannot fairly be construed to be a server.

For at least these reasons claim 1 is allowable over the cited prior art. As claims 2 – 8 depend from claim 1, Applicants respectfully submit that such claims are also allowable.

Claim 9

Amended claim 9 recites in part "...means, responsive to a user request via the client device for Web content, for retrieving an advertisement from the advertisement server in response to the subject matter of the Web content; [and] means for inserting the retrieved advertisement within the user requested Web content...". As described, relative to claim 1, inserting a content or subject matter related advertisement, as in the claim, cannot fairly be said to be equivalent to inserting two words to make a complete phrase out of a series of fields in a database, as cited from Dames by the Office Action. Neither Dames, Funk, nor Logan teaches such a limitation. For at least these reasons, claim 9 is allowable over the cited prior art. As claims 10 through 19 depend from claim 9, Applicants respectfully submit that such claims are also allowable.

Claims 20, 27, 39 and 46

With regard to Claims 20, 27, 39 ,and 46, the Examiner has not provided any specific rejection of any of such independent claims. The Examiner states that they are similarly rejected for at least the reasons set forth for Claims 1 and 9. Applicants respectfully submit that Claims 20, 27, 39, and 46 are not identical to Claims 1 and 9 and that a prima facie case of obviousness has not been made with respect to any such claims. Further, Applicants reiterate each of the remarks set forth above with respect to Claims 1 and 9. For at least these reasons, Applicants respectfully submit that Claims 20, 27, 39, and 46 are allowable over the cited prior art. As Claims 21-26, 28 – 38, 40-45, and 47-56 depend from claims 20, 27, 39, and 46 respectively, Applicants respectfully submit that such claims are also allowable.

Claim 57

Regarding claim 57, the claim cites in part "...wherein the advertisement has a text-based format and is configured to be interactive when converted to an audio format." There is no citation to relevant prior art for "...and is configured to be interactive when converted to an audio format..." in the rejection. Because each element is not disclosed in the prior art, a prima facie case of obviousness has not been made. Therefore, Applicants respectfully request the objection be withdrawn.

Additionally, Claim 57 recites "...means for receiving notification from a text-to-speech transcoder that the selected advertisements has been delivered to the client device in an audio format...." The Office Action cites to several sections of Wu for this element of the claim, none of which appear to suggest or disclose the elements of the claim. For example, paragraph [0030] states in part "The handheld computer 20 may be configured to send a notification to the advertisement server 54 that the audio channel is off so that the advertisement server 54 sends text advertisements instead of audio advertisements....When the audio channel is opened, a notice is sent back to the advertisement server 54 so that the advertisement server can again send audio advertisements...." The notification here is regarding the status of the audio channel (whether the audio channel is on or off), not a notification that a selected advertisement has been delivered to the user client device in an audio format. There is simply no notification here of the receipt of a selected advertisement. Paragraph [0041] lines 17 – 30 is once again referring to actions that occur when the audio channel is turned on and actions that occur when the audio channel is turned off. None of the actions involve a notification (or confirmation) that an advertisement has been delivered to the user client device in an audio format. Lastly, Figure 3 and paragraph [0032] also do not describe notification from a text-to-speech transcoder. Figure 3 depicts the text-to-to speech transcoder as being part of an advertisement server and gives no indication of any notifications going from the text-to-speech system to the advertisement server. Paragraph [0032] similarly provides no notification of selected advertisement delivery in an audio format.

Wu, and in particular the cited passages, fail to provide a means for receiving notification from a text-to speech transcoder that the selected advertisement has been delivered to the user device in an audio format. Specifically, no notification of delivery to the advertising server is mentioned anywhere in Wu, nor is this found in Logan. Accordingly, Applicant respectfully request the withdrawal of the rejection of claim 57.

For at least these reasons, Applicants respectfully submit that Claim 57 is allowable over the cited prior art. As Claims 58 – 62 depend from Claim 57, Applicants respectfully submit that such claims are also allowable.

CONCLUSION

For the foregoing reasons, and for other apparent reasons, Applicants respectfully request reconsideration and favorable action. If the Examiner feels a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe that no fee is due,. However, the Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 50-2816, under Order No. 020748.0224PTUS. A duplicate copy of this paper is enclosed.

Dated: 11/30/2007

Respectfully submitted,

By _____

Darren Collins
Registration No.: 44,625
PATTON BOGGS LLP
2001 Ross Avenue, Suite 3000
Dallas, Texas 75201
214-758-3552 (OFFICE)
214-758-1550 (FAX)
Attorney for Applicants